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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,302

06/09/2008

John Gordon Allen

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ELI LILLY & COMPANY

PATENT DIVISION

P.O. BOX 6288

INDIANAPOLIS, IN 46206-6288

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

09/24/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

Office Action Summary	Application No. 10/598,302	Applicant(s) ALLEN ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15, 16, 18-21, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15, 16, 18-21, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/24/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-12, 15, 16, 18-21, 24 and 25 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 6-8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondinell et al., EP 0 285 287. The generic structure of Bondinell encompasses the instantly claimed compounds as claimed herein. Example 4, etc. differ only in the substitution of the phenyl ring at the 6-position of the 2,3,4,5-tetrahydro-1H-3-benzazepine. The compounds of formula I of the instant invention, differs only in the substitution on the benzazepine ring, i.e. R³ where R³ is defined on page 2 as a phenyl where the phenyl is optionally substituted phenyl by hydroxyl, C₁-C₈ alkoxy, halogen, CF₃, C₁-C₈ alkyl, SO_n(C₁-C₆) alkyl, SO_nCF₃, SO_nphenyl or SO₂NR⁵R⁶. The definition of R¹ is hydrogen, C₁-C₆ alkyl or C₃-C₅ alkenyl and R² is hydrogen, halogen, CF₃, C₁-C₆ or R⁴O. The compounds and compositions of the compounds of formula (I) of the instant invention are generically embraced by Bondinell in view of the interchangeability of the substitutions of the benzazepine ring in the 6-position of the compounds. Thus, one of ordinary skill in the art at the time the invention was made would have been motivated to select for example p-fluorophenylthio as well as other

possibilities from the generically disclosed alternatives of the reference and in so doing obtain the instant compounds in view of the equivalency teachings outlined above.

2. Claims 1-3, 5-8, 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarinis et al., WO 93/03015. The generic structure of Demarinis encompasses the instantly claimed compounds as claimed herein. The examples differ only in the substitution of the 2,3,4,5-tetrahydro-1H-3-benzazepine. The compounds of formula I of the instant invention, differs in the substituent X. The definition of X includes various substitutions such as hydrogen, Cl, Br, F, I, CF₃, C₁₋₆alkyl, COR¹, CO₂R², CONR²R², CN, NO₂, NR³R⁴, OR³, SR¹, SCF₃, or any accessible combination thereof up to three substituents. The compounds and compositions of the compounds of formula (I) of the instant invention are generically embraced by Demarinis in view of the interchangeability of the substitutions of the benzazepine in the 9-position of the compounds. Thus, one of ordinary skill in the art at the time the invention was made would have been motivated to select for example hydrogen as well as other possibilities from the generically disclosed alternatives of the reference and in so doing obtain the instant compounds in view of the equivalency teachings outlined above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 15, 16, 18-21, 24 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 8-11, 14 and 15 of copending Application No. 11/995,344. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula I of the

instant invention are embraced by the compounds, compositions and method of use of the compounds of formula I of 11/995,344 where R^6 is $-C\equiv C-R^{10}$.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

4. Claims 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624